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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,245	04/02/2001	Yoshikatsu Ooi	1114-160	6730
23117	7590	07/28/2005	EXAMINER SINGH, SATWANT K	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			ART UNIT 2626	PAPER NUMBER
DATE MAILED: 07/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/822,245	OOI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Satwant K. Singh	2626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.  
 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1, 3, and 5-21 is/are rejected.  
 7) ☒ Claim(s) 2 and 4 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
 1. ☒ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action in response to the amendment filed on 04 April 2005.

### ***Response to Arguments***

2. Applicant's arguments with respect to claim1 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that the prior art of Tsukui et al fails to disclose the storage of partial e-mail addresses comprising two or more of the e-mail address parts as set forth in claim 1. Tsukui discloses dividing the domain name into two, namely, top domain name and sub-domain name (col. 5, lines 51-55).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 5-9, 11-18, and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsukui et al. (US 6,557,045).
5. Regarding Claim 1, Tsukui et al disclose a communication terminal apparatus capable of sending and receiving e-mails comprising: an input section for entering an e-mail address (operation panel 107) (an operator can input a character string such as a mail address) (col. 3, lines 28-32); a storage section for storing a plurality of partial e-

mail addresses (backup ram 106 stores address data which is divided and extracted by an address edit operation) (col. 5, lines 20-21), at least one of the partial e-mail addresses stored in the storage section comprising two or more different e-mail address parts (dividing the e-mail address into at least two) (col. 5, lines 51-55); and a selection section for selecting one from among the stored partial e-mail addresses (Fig. 7, S602, a selection of domain name is carried out to select an address ) (col. 6, lines 22-23); wherein in entering an e-mail address, a portion of the e-mail address is first entered from the input section ( Fig. 7, S610, a user name is inputted) (col. 6, line 40) and then the partial e-mail address selected from the storage section by the selection section is combined with the portion of the e-mail address entered from the input section to complete the e-mail address entry (Fig. 7, S611, the inputted user name is ascertained, and the entirety inputted address is also ascertained) (col. 6, lines 50-51).

6. Regarding Claim 3, Tsukui et al disclose a communication terminal apparatus, wherein the plurality of partial e-mail addresses stored in the storage section is classified into predetermined categories (user name, sub-domain name 1, sub domain name 2, top domain name, which are divisionally stored in the backup RAM 106) (col. 5, lines 39-56) and selection from among the stored partial e-mail addresses is carried out in response to selection of one from the predetermined categories (scroll buttons are arranged at the positions corresponding to the display portions of the sub-domain name, top domain name, which are displayed by the display device) (col. 5, lines 63-67, col. 6, lines 1-7).

7. Regarding Claim 5, Tsukui et al disclose a communication terminal capable of sending e-mail comprising: a user-operable input section (operation panel 107) (an operator can input a character string such as a mail address) (col. 3, lines 28-32); a storage section for storing one or more partial e-mail addresses each comprising at least a top-level domain name and a sub-level domain name (user name, sub-domain name 1, sub domain name 2, top domain name, which are divisionally stored in the backup RAM 106) (col. 5, lines 39-56); and a selection section for selecting one of the partial e-mail addresses (Fig. 7, S602, a selection of domain name is carried out to select an address ) (col. 6, lines 22-23), wherein a complete e-mail address of an e-mail recipient is specified by combining an e-mail address portion input using the input section with the selected partial e-mail address (Fig. 7, S611, the inputted user name is ascertained, and the entirety inputted address is also ascertained) (col. 6, lines 50-51).
8. Regarding Claim 6, Tsukui et al disclose a communication terminal wherein the partial e-mail address stored in the storage section are organized into categories (user name, sub-domain name 1, sub domain name 2, top domain name, which are divisionally stored in the backup RAM 106) (col. 5, lines 39-56).
9. Regarding Claim 7, Tsukui et al disclose a communication terminal wherein the categories include a category for partial e-mail addresses comprising a top-level domain name and a sub-level domain name (sub-domain name 1, sub domain name 2, top domain name, which are divisionally stored in the backup RAM 106) (col. 5, lines 39-56).

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10. Regarding Claim 8, Tsukui et al disclose a communication terminal wherein the selection section comprises one or more keys usable to select one of the categories (scroll buttons are arranged at the positions corresponding to the display portions of the sub-domain name, top domain name, which are displayed by the display device) (col. 5, lines 63-67, col. 6, lines 1-7).

11. Regarding Claim 9, Tsukui et al disclose a communication terminal wherein the selection section comprises one or more keys usable to step forward and backward through the partial e-mail addresses (scroll buttons are arranged at the positions corresponding to the display portions of the sub-domain name, top domain name, which are displayed by the display device) (col. 5, lines 63-67, col. 6, lines 1-7).

12. Regarding Claim 11, Tsukui et al disclose a communication terminal embodied as a facsimile apparatus (Internet facsimile apparatus) (col. 2, lines 65-66).

13. Regarding Claim 12, Tsukui et al disclose a communication terminal capable of sending e-mail comprising: a display section (Fig. 6, display 108); a keypad (Fig. 6, operational panel 107); and a storage section for storing one or more partial e-mail addresses each comprising two or more different e-mail parts (dividing the e-mail address into at least two) (col. 5, lines 51-55), wherein a complete e-mail address of an e-mail recipient is specified by combining one or more e-mail address parts (user name) (col. 5, lines 51-55) with two or more e-mail address parts (domain name may be divided into two) (col. 5, lines 51-55) designated by making a single selection from a display of the partial e-mail addresses displayed on the display section (Fig. 7, S611,

the inputted user name is ascertained, and the entirety inputted address is also ascertained) (col. 6, lines 50-51).

14. Regarding Claim 13, Tsukui et al disclose a communication terminal wherein the one or more e-mail address parts is input by character using the keypad (operational panel 107) (an operator can input a character string such as a mail address) (col. 3, lines 28-32).

15. Claim 14 and 18 are rejected for the same reason as claim 6.

16. Claim 15 is rejected for the same reason as claim 7.

17. Regarding Claim 16, Tsukui et al disclose a communication terminal, wherein the keypad comprises one of more keys for selecting one of the categories (Fig. 6, scroll buttons 703, 704, and 705).

18. Regarding Claim 17, Tsukui et al disclose a communication terminal, wherein the keypad comprises on or more keys for stepping forward and backward through the partial e-mail addresses (Fig. 6, scroll buttons 703, 704, and 705) (scroll buttons are arranged at the positions corresponding to the display portions of the sub-domain name, top domain name, which are displayed by the display device) (col. 5, lines 63-67, col. 6, lines 1-7).

19. Claim 20 is rejected for the same reason as claim 11.

20. Regarding Claim 21, Tsukui et al disclose a communication terminal apparatus capable of sending and receiving e-mails comprising: an input section for entering e-mail address (operation panel 107) (an operator can input a character string such as a mail address) (col. 3, lines 28-32); a storage section for storing a plurality of partial e-

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mail addresses (backup ram 106 stores address data which is divided and extracted by an address edit operation) (col. 5, lines 20-21), wherein the storage section is configured so that one of the stored partial e-mail addresses can be the same as one or more of the e-mail address parts of another one of the stored partial e-mail addresses (dividing the e-mail address into at least two) (col. 5, lines 51-55); and a selection section for selecting one from among the stored partial e-mail addresses (Fig. 7, S602, a selection of domain name is carried out to select an address ) (col. 6, lines 22-23); wherein in entering an e-mail address, a portion of the e-mail address is first entered from the input section ( Fig. 7, S610, a user name is inputted) (col. 6, line 40) and then the partial e-mail address selected from the storage section by the selection section is combined with the portion of the e-mail address entered from the input section to complete the e-mail address entry (Fig. 7, S611, the inputted user name is ascertained, and the entirety inputted address is also ascertained) (col. 6, lines 50-51).

***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukui et al in view of Laiho et al. (US 6,151,507).

23. Regarding Claim 10, Tsukui et al fail to teach a communication terminal embodied as a mobile telephone (Fig. 2, cellular radiotelephone 10).



Laiho et al teach a communication terminal embodied as a mobile telephone.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Tsukui with the teaching of Laiho to allow for storage of partial e-mail addresses for ease of inputting e-mail addresses.

24. Claim 19 is rejected for the same reason as claim 10.

***Allowable Subject Matter***

25. Claims 2 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Satwant Singh*

Satwant K. Singh  
Examiner  
Art Unit 2626

sks

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